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IN THE UNITED STATES DISTRICT COURT
DISTRICT OF UTAH, CENTRAL DIVISION

DIVERSI-PLAST PRODUCTS, INC., a
Minnesota Corporation,

Plaintiff,

v.

BATTENS PLUS, INC., a California
Corporation,

Defendant.

AND RELATED COUNTERCLAIMS

Case No. 2:04CV01005 PGC

**DEFENDANT'S THIRD MOTION FOR
SUMMARY JUDGMENT**

TO PLAINTIFF DIVERSI-PLAST PRODUCTS, INC., AND ITS ATTORNEYS OF
RECORD HEREIN:

This is the third of three summary judgment motions brought by Defendant Battens Plus, Inc. ("Battens Plus"). In this motion, Battens Plus seeks a judgment that the patent being asserted by Plaintiff Diversi-Plast, Inc. ("Diversi-Plast") is invalid for the following reasons: the patent is anticipated under 35 U.S.C. § 102(a), it is obvious under 35 U.S.C. § 103, and the

invention claimed in the patent existed previously. In addition, Battens Plus seeks a judgment that Battens Plus' accused product does not directly infringe the patent.

Battens Plus respectfully requests under Federal Rule of Civil Procedure 56 that summary judgment be granted against Diversi-Plast's sole claim of patent infringement and in favor of Battens Plus' First and Second Counterclaims seeking declarations that U.S. Patent No. 6,357,193 B1 (the "'193 patent") is invalid and not infringed.

DATED: March 31, 2006..

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**MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
DEFENDANT'S THIRD MOTION
FOR SUMMARY JUDGMENT**

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I. INTRODUCTION

This is the third of three summary judgment motions brought by Defendant Battens Plus, Inc. ("Battens Plus"). In this motion, Battens Plus seeks a judgment that the patent being asserted by Plaintiff Diversi-Plast, Inc. ("Diversi-Plast") is invalid for the following reasons: the patent is anticipated under 35 U.S.C. § 102(a), it is obvious under 35 U.S.C. § 103, and the invention claimed in the patent existed previously. In addition, Battens Plus seeks a judgment that Battens Plus' accused product does not directly infringe the patent.¹

For those reasons, Battens Plus respectfully requests under Federal Rule of Civil Procedure 56 that summary judgment be granted against Diversi-Plast's sole claim of patent infringement and in favor of Battens Plus' First and Second Counterclaims seeking declarations that U.S. Patent No. 6,357,193 B1 (the "'193 patent") is invalid and not infringed.

The issues addressed by this motion require the Court to construe claim 2 of the '193 patent.² Claim construction is necessary because the Court must first determine the meaning of the limitations in the claim before it may compare those limitations to the prior art, the prior inventive activity discussed herein, and Battens Plus' accused product. Because Battens Plus anticipates that the Court will require additional briefing on the interpretation of certain claim terms, such briefing is minimized here. Where construction is necessary for the purposes of this motion, Battens Plus describes and assumes those constructions.

¹ Diversi-Plast asserts that only Claim 2 of the '193 Patent is infringed by Battens Plus. Declaration of Michael Wilcox, Ex. A, at RFA No 1; Wilcox Dec., Ex. B, at Interrog. No. 1; Battens Plus has relied upon this assertion, appearing in Diversi-Plast's discovery responses, and contends that Diversi-Plast is now precluded by Fed. R. Civ. Proc. 37(c)(1) from asserting infringement of any other claim of the '193 Patent.

² Battens Plus files this motion before claim construction to comply with the dispositive motion deadline. Battens Plus, however, does not anticipate the Court will rule on this motion until after claim construction is completed.

II. STATEMENT OF UNDISPUTED FACTS

The following is a list of undisputed material facts relevant to this motion:

1. Claim 2 of the '193 Patent is the only claim Diversi-Plast alleges is being infringed by Battens Plus. Wilcox Dec., Ex. A, at RFA No. 1; Wilcox Dec., Ex. B at Interrog. No. 1.³

2. Claim 2 is a dependant claim that depends from Claim 1. Claim 2, therefore, includes all the elements in Claim 1 as well as all the elements in Claim 2.

3. Claim 1 reads:

A tile roof system, comprising:
an overlayment;
a tile; and
a batten disposable between the tile and the overlayment,
the batten comprising:
at least one layer comprising a generally planer first ply and
a second ply, the first and second plies cooperating
to define a multiplicity of passages extending
generally transversely to a longitudinal axis of the
batten.

Wilcox Dec., Ex. C, at 5:23-34.

4. Claim 2 reads:

The batten of claim 1, in which the second ply includes a
multiplicity of cross plies extending between the first plies.

Id. at 5:35-36.

5. U.K. Patent Application GB 2062056A ("the '056 application") is a United Kingdom patent application that was published on May 20, 1981, more than one year prior to December 16, 1998, the date of the application to which the '193 patent claims priority. The '056 application is prior art to the '193 patent. Wilcox Dec., Exs. C, G, and H.⁴

³ Diversi-Plast qualified its discovery responses as to which claims it would assert so as to reserve the right to assert additional claims. Diversi-Plast has never so amended its responses and is now precluded from doing so by Fed. R. Civ. Proc. 37(c)(1).

⁴ On March 14, 2005, Diversi-Plast filed an Information Disclosure Statement with the U.S. Patent and Trademark Office listing '056 application as a prior art reference to the '193 patent

6. The '056 application describes roof battens as shown in Figs. 1 and 6 from the application:

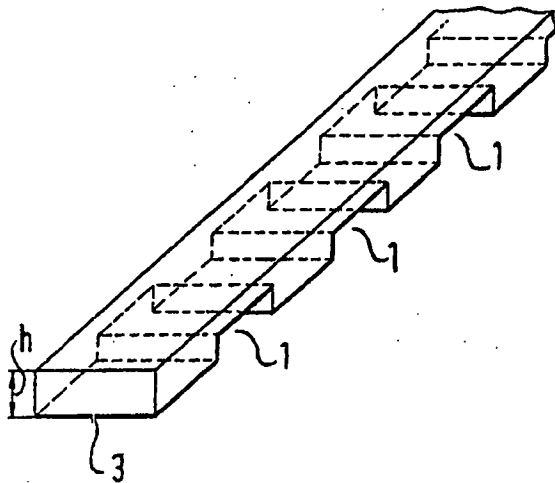


Fig. 1

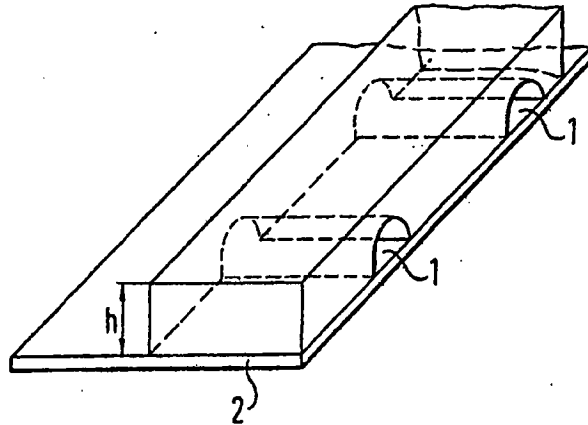


Fig. 6

The '056 application also states:

Figure 6 shows part of a roofing lath, which for example can be formed by a roof lath according to Figure 1 or Figure 2 fitted on to a baseplate 2. This embodiment can also be made in one piece, for example or an extruded plastics material in which the apertures 1 are formed subsequently.

Wilcox Dec., Ex. G, at p. 2, lines 87-92 (emphasis supplied).

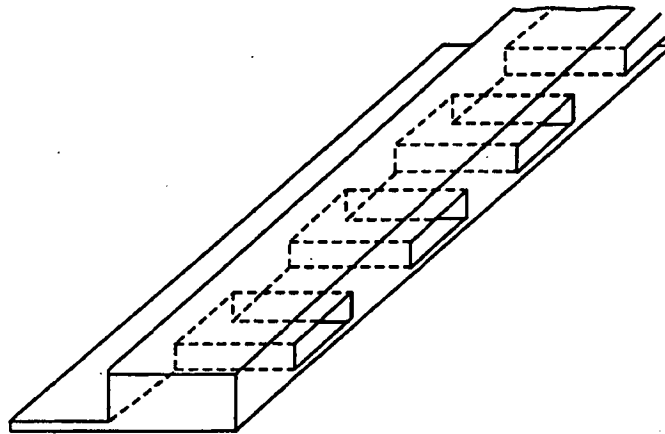
A person having ordinary skill in the relevant art would interpret the teaching of this passage along with the illustrations it references as disclosing a batten with the following structure:

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///

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and admitting that the '056 application was published on May 20, 1981. The Information Disclosure Statement also attached a copy of the '056 application and that copy is identical to Wilcox Dec., Ex. G.



Declaration of Philip Dregger, Exhibit C.

7. The teaching of the '056 application at page 2, lines 87-92 disclose each and every limitation of claims 1 and 2 of the '193 patent relating to the structure of a batten. Wilcox Dec., Ex. G; Dregger Dec., Ex. C.

8. The '056 application also discloses a roof batten have the structure shown in Fig. 2 of that application:

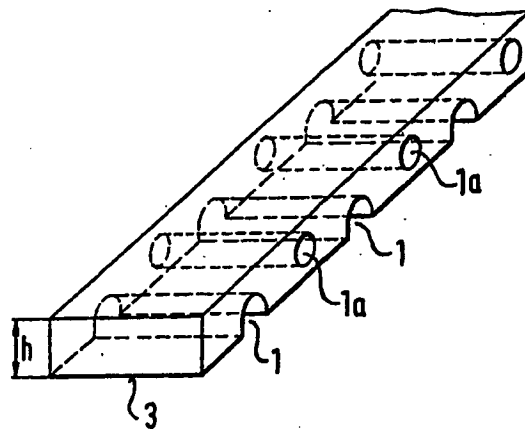


Fig. 2 of the '056 application

Wilcox Dec., Ex. G.

9. The teaching of the '056 application at Fig. 2 disclose each and every limitation of claims 1 and 2 of the '193 patent relating to the structure of a batten. Wilcox Dec., Ex. G.

10. Prior to December 17, 1998, the filing date of the application to which the '193

patent claims priority, Cor-A-Vent, Inc. sold certain ridge vent products to the public for use in roofing construction, including the Cor-A-Vent V-300 and V-400 series ridge vents. Dregger Dec., Ex. D is a schematic drawing that accurately represents the structure of these ridge vents as they existed at some time prior to December 17, 1998. Dregger Dec., at ¶ 5. Dregger Dec., Ex. E is a Cor-A-Vent brochure that accurately represents the use of the V-400 series ridge vents prior to December 17, 1998.

11. A person having ordinary skill in the relevant art would have been motivated to combine the teaching of the '056 application and the Cor-A-Vent V-300 and V-400 series ridge vents to obtain each and every limitation of claim 2 of the '193 patent. Dregger Dec., Ex. A, at pp. 8-12.

12. U.S. Patent No. 5,304,095 ("the '095 patent") was issued by the United States Patent and Trademark Office on April 19, 1994, prior to December 17, 1998, the filing date of the application to which the '193 patent claims priority. The '095 patent is prior art to the '193 patent. The '095 patent discloses a ridge cap type roof ventilator. Wilcox Dec., Ex. I; Dregger Dec., Ex. A.

13. A person having ordinary skill in the relevant art would have been motivated to combine the teaching of the '056 application and the '095 patent to obtain each and every limitation of claim 2 of the '193 patent. Dregger Dec., Ex. A, at pp. 8-12.

14. During the summer of 1997, Lars Walberg formulated the idea of using a corrugated plastic product as a batten. Wilcox Dec., Ex. J, at 30:5-6, 31:2-34:2. Based on this idea, Mr. Walberg requested a product from Diversi-Plast that might be used as a batten. *Id.* at 34:3-35:9. Diversi-Plast sent Mr. Walberg several of its soffit vent products for experimentation. *Id.* at 34:20-35:9. Mr. Walberg then built a simulated roof deck, placed the soffit vent/battens on roofing felt on this deck and placed tiles on top of the battens. *Id.* at 36:3-38:14; Wilcox Dec., Ex. K; Wilcox Dec., Ex. J, at 38:11-21.

15. The soffit vent that Mr. Walberg used as a batten in the summer of 1997 meets each and every limitation of claim 2 of the '193 patent relating to the structure of the batten. Wilcox Dec., Ex. K; Wilcox Dec., Ex. L, at 162:2-167:13; Wilcox Dec., Ex. J, at 47:15-49:20.

16. Mr. Walberg conceived and reduced his invention to practice before Mr. Morris conceived and reduced to practice any invention that contributed or led to claim 2 of the '193 patent. Wilcox Dec., Ex. W; Wilcox Dec., Ex. V, at 37:21-38:21; Wilcox Dec., Ex. L, at 29:23-30:6, 30:16-19, 116:19-117:20.

III. BACKGROUND

A. The '193 Patent

The '193 patent issued on March 19, 2002 and claims priority to a provisional application filed on December 17, 1998. The sole inventor listed on the '193 patent is Richard J. Morris. Wilcox Dec., Ex. C, at p. 1. The '193 patent is directed toward a tile roofing system employing a batten. The typical configuration for such a system is plywood on top of which is placed roofing felt, a batten, and then an outer layer of tiles. The batten itself is a spacer about 3/8 inches tall by 1 1/2 inches wide which is placed parallel to the ridge of the roof and perpendicular to its slope. Fig. 10 of the '193 patent illustrates a typical roof configuration. Wilcox Dec., Ex. C.

The '193 patent purportedly solves a problem with prior art solid wood battens. Because they were solid, such battens trapped water that had infiltrated the tiles on the upper slope side of the batten. The '193 patent solves this problem by purportedly claiming a plastic batten with channels that allow the water to drain and air to flow underneath the tiles. Fig. 2 of the '193 patent shows one configuration of this batten. *Id.* at 4:63-5:1.

B. Proceedings Before the U.S. Patent and Trademark Office

The '193 patent is currently the subject of a combined reissue / reexamination proceeding pending before the U.S. Patent and Trademark Office. On March 19, 2004, seven months before

filing its infringement suit against Battens Plus, Diversi-Plast initiated reissue proceedings with the U.S. Patent and Trademark Office. Wilcox Dec., Ex. M. In its initial amendment submitted with its reissue application, Diversi-Plast modified the patent's original claim 2 and added new claims 23-25, which depend from claim 2. *Id.* In its first office action, the Patent Office rejected independent claims 1, 14, and 22 as invalid in view of prior art and objected to all associated dependant claims. Wilcox Dec., Ex. N. On May 3, 2005, Diversi-Plast participated in a teleconference with the Patent Office examiner to resolve problems with the claims. As a result of this conference, Diversi-Plast voluntarily cancelled claims 1, 14-20 and 22 of the original patent, modified claims 2 and 3 to incorporate the language of cancelled claim 1 and made further minor modifications to claims 6, 8, and 9. Wilcox Dec., Ex. O.

After Diversi-Plast filed suit, Battens Plus filed a Request for Reexamination citing seven prior art references that alone or in combination render each of the original '193 patent claims invalid. Wilcox Dec., Ex. P, at Req. No. 2. The Patent Office granted Battens Plus' reexamination request on May 24, 2005 stating that substantial new questions of patentability existed as to each of the original claims. On July 13, 2005, the Patent Office *sua sponte* merged the reissue and reexamination proceedings. Wilcox Dec., Ex. Q.

Most recently, the Patent Office rejected all of the pending claims as anticipated by prior art cited in Battens Plus' Reexamination Request. Wilcox Dec., Ex. R. In response Diversi-Plast voluntarily withdrew claim 21 and objected to the invalidation of the others. Wilcox Dec., Ex. S. Diversi-Plast also submitted a request to change the inventorship of the patent, adding Lars Walberg as a co-inventor. Wilcox Dec., Ex. T.

As it now stands, Diversi-Plast has cancelled ten of the original twenty-two claims of the '193 patent and the Patent Office has tentatively held the remaining claims invalid.

IV. LEGAL STANDARD FOR SUMMARY JUDGMENT

Summary judgment is appropriate if, viewing all facts in the light most favorable to the

nonmoving party, there is no genuine issue as to any material fact, and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986).

Once a motion for summary judgment is made and supported, the non-moving party may not rest on the mere allegations or denials of his pleadings, but must set forth specific facts showing that there is a genuine issue for trial. Fed. R. Civ. P. 56(e). Moreover, the "mere existence of a scintilla of evidence in support of the nonmovant's position is insufficient to create a genuine issue of material fact." *Johnson v. Lindon City Corp.*, 405 F.3d 1065, 1068 (10th Cir. 2005). Rather, the nonmovant must present facts upon which a reasonable jury could find in favor of the nonmovant. *Id.*

V. ARGUMENT

A. Claim 2 of the '193 Patent is Anticipated by the '056 Application.

Claim 2 is anticipated as a matter of law by U.K. Patent Application GB 2062056A ("the '056 application") that was published in 1981. Wilcox Dec., Ex. G, at p. 1, lines 43-44. The '056 application describes a replacement for "espalier lathing." Such lathing consists of strips of wood installed beneath and running perpendicular to solid wood lathes to allow water that would otherwise pool against the side of the lathes to drain.⁵ *Id.* at p. 1, lines 6-21. The '056 application proposes several alternative lathe/batten designs, having channels that allow the passage of water and air through the batten, that would eliminate the need for espalier lathing. *Id.* at page 1, lines 59-62; Figs. 1-8. Hence, the '056 application is directed toward the same problem as the '193 patent and solves that problem utilizing the same idea.

1. Legal Standard for Anticipation

"A single prior art reference that discloses, either expressly or inherently, each limitation

⁵ The '056 application uses the word "lathe" rather than "batten," however, it is clear from the description of the lathes and the way in which they are used that the "lathe" of the '056 application is the same as the batten of the '193 patent and an ordinarily skilled artisan in the relevant art would so understand. Dregger Dec. Ex. A, at p. 6.

of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005); 35 U.S.C. § 102(a). "Anticipation based on a printed publication under section 102(a) requires the presence in the publication of each and every limitation of the claimed invention." *Novo Nordisk v. Bio-Technology General*, 424 F.3d 1347, 1354 (Fed. Cir. 2005). As shown here, to undertake an anticipation analysis this Court must compare the prior art reference to each limitation of the claim. To perform this task requires that this Court first construe the claim limitations so as to determine their scope and meaning. *Helifix Ltd., v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000) ("The first step in an anticipation analysis is claim construction.").

2. Claim Construction

As previously stated, Battens Plus believes that the parties should separately brief claim construction, however, because the construction of claims is necessary to analyze anticipation, Battens Plus sets forth possible constructions here along with a short discussion of their basis.⁶

The parties will dispute the meaning of the description of the batten appearing in claim 1 at column 5, lines 30-34 and claim 2 at column 5 lines 35-36.⁷ These descriptions read as follows:

1. . . .

the batten comprising:

at least one layer comprising a generally planar first ply and a second ply, the first and second plies cooperating to define a multiplicity of passages extending generally transversely to a longitudinal axis of the batten.

2. The batten of claim 1, in which the second ply includes a multiplicity of cross-ply extending between the first plies.

⁶ Any construction of claim 2 assumes that claim 2 would make sense to an ordinarily skilled artisan in the first place. As shown in the section 112 discussion appearing in companion motions, it would not. The "plies" referred to in claim 2 lack an antecedent basis in claim 1 because claim 1 refers to a single first ply. Thus claim 2 is indefinite. The constructions discussed herein presume (incorrectly) that claim 2 implies a second first ply and is, therefore, not invalid for indefiniteness. By making this assumption, Battens Plus does not contradict its assertion that the claim should be held indefinite and invalid.

⁷ Disputes over claim construction do not preclude summary judgment as the meaning of the claims is a matter of law that must be definitively resolved by this Court prior to submission to a jury. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 376-91 (1996).

Wilcox Dec., Ex. C. The parties will differ as to the meaning assigned to "ply" and "cross plies" in this description. Claim 1 describes each ply separately suggesting that each is a separate structure. Fig. 4 and the accompanying descriptive text (*Id.* at 3:12-17), confirm that a ply is a separate divisible structure that is "bonded to (or otherwise cooperates with)" other plies.⁸ *Id.* at 3:15. Under this interpretation, the following are two different plies, the first a generally planar ply and the second a convoluted ply:

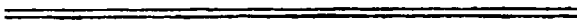


Illustration 1



Illustration 2

As required by claim 1, these two plies cooperate with one another to define a multiplicity of passages as shown in the following portion of Fig. 4:



Illustration 3 (Portion of Fig. 4 of the '193 patent)

Based on Fig. 5 and its descriptive text (*Id.* at 3:18-25), however, the "second ply" of claim 2 may not be a separate divisible structure as no lines appear separating the second ply in Fig. 5 from the planer plies.⁹ The missing line also contradicts the structure of the "planer ply" shown in Fig. 4, because it suggests that the planer ply may not be a divisible structure, as indicated by Fig. 4 and by claim 1. It also appears that the second ply of Fig. 5 is a discontinuous structure (i.e. "a multiplicity of cross plies") appearing as follows:

⁸ Battens Plus looks primarily to the '193 patent specification for the meaning of the claim terms. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) ("The specification is, thus, the primary basis for construing the claims.")

⁹ Although Diversi-Plast will argue that the structure of Fig. 5 would fall within the limitations of claim 2, this is not required. Fig. 5 merely sheds light on how claim 2 may be interpreted. In addition, if the structure of Fig. 5 falls within the limits of claim 2, it must also fall within the limits of claim 1, as claim 2 depends from claim 1. *AK Steel Corp. v. Sollac*, 334 F.3d 1234, 1241 (Fed. Cir. 2003).



Illustration 4

Thus, there is intrinsic evidence both for and against the argument that claim 2 requires separate divisible plies. Battens Plus does not here commit itself to either interpretation other than to state that one leads to invalidity and the other to non-infringement.

Finally, there is no language in claim 2 dictating the shape or limiting the thickness of each of the cross-ply of the second ply. In addition, although the cross-ply appearing in Illustration 4 and in Fig. 5 of the '193 patent are perpendicular, this is not required by the claim and such an interpretation is specifically rejected by the patent specification which states: "Cross plies 64 extend generally perpendicular (or otherwise transversely) between the planer plies." Wilcox Dec., Ex. C at 3:21-22 (emphasis supplied). Based on the language of claim 2 and the specification, the cross-ply of the second ply could include many different structures.

3. Anticipation by the '056 Application

The '056 Application contains every limitation of claim 2 of the '193 patent and therefore anticipates that claim. Claim 2 depends from claim 1. Claim 2, therefore, incorporates every limitation appearing in claim 1 and adds its own further limitations to those. 35 U.S.C. § 112; *Curtiss-Wright Flow Corp. v. Velan Inc.*, 2006 U.S. App. LEXIS 3521 at *15 (Fed. Cir., Feb. 15, 2006). Anticipatory prior art must therefore meet each limitation of claim 1 in order to meet the limitations of claim 2.

The first limitation of claim 1 is "an overlayment." Wilcox Dec., Ex. G at 5:25. The '193 patent specification suggests that the term "overlayment" includes "felt paper." *Id.* at 19-22. The '056 application discloses the use of felt paper at, for example, page 1, lines 6-11 and lines 115-18. This disclosure meets the first limitation of claim 1. The second limitation of claim 1 is "a

tile." *Id.* at 5:26. A "tile" is not specifically described in the patent specification other than as pictured in Fig. 10 (labeled "110"). The '056 application discloses a tile at, for example, page 1, line 62 and, therefore, meets this limitation. The third limitation of claim 1 requires that there be a "batten disposable between the tile and the overlayment." *Id.* at 5:27. The '056 application states that the described lathe/battens can be placed directly on roofing felt (page 1, lines 52-58) and that roofing tiles will be placed on top (page 1, lines 82-83).

The remaining limitations of claim 1 and those of claim 2 relate to the structure of the batten. For purposes of this discussion, Battens Plus assumes that "first ply" and "second ply" described in claim 2 need not be discrete separate structures - as in they conform to Fig. 5 of the '193 patent, rather than Fig. 4. As previously stated, Battens Plus also here assumes that claim 2 implies a second first ply limitation.

The '056 application discloses an "especially preferred embodiment" in which a lathe sits atop a base plate as is illustrated in Fig. 6. Wilcox Dec., Ex. G, at page 1, 94-101; UF at ¶ 11. Most relevant to claim 2 of the '193 patent is the passage at page 2, lines 87-93 of the '056 application, which states that the lathe of Fig. 1 and the base plate of Fig. 6 can be made in "one piece" composed of "an extruded plastics material."¹⁰ An ordinarily skilled artisan would understand this passage to disclose the following structure:

///

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¹⁰ The fact that the bottom of this structure is labeled a "base plate" has no negative impact on the anticipation analysis. Because the '056 application states that the lathe and base plate can be made in "one piece," the base plate and lathe are effectively a single structure that can be compared to the structure claimed by the '193 patent.

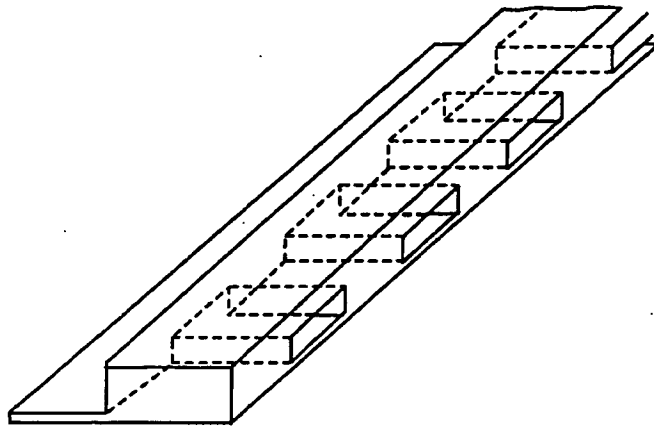


Illustration 5

UF at ¶ 11; Dregger Dec., Ex. C.

This structure discloses all the limitations of claim 1 and claim 2 relating to the structure of the batten. Illustration 6 shows a cross-section of the structure shown in Illustration 5:

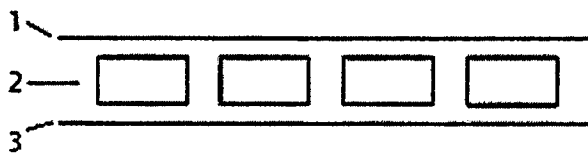


Illustration 6

In Illustration 6, the "generally planer first ply" of claim 1 is labeled "1." The "second ply" including "a multiplicity of cross plies" of claim 2 is labeled "2" and the second "first ply", if such a ply can be assumed from claim 2, appears at "3." That the bottom ply is wider than the other plies has no impact on anticipation as claim 2 does not limit the width of the second first ply.¹¹ Thus, the '056 application discloses each limitation of claim 2 and, therefore, anticipates that claim.

Finally, the '056 application discloses a batten, illustrated in Fig. 2, that without further description anticipates claim 2 of the '193 patent. Fig. 2 of the '056 application appears in Illustration 7:

¹¹ If this Court were to find that a second first ply should be assumed in claim 2, Battens Plus submits that there should be no limitations placed on its structure as it is in no way limited by the language of the claim.

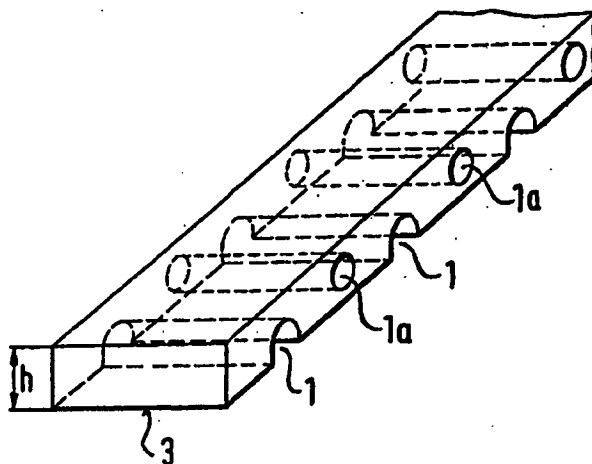


Illustration 7 (Fig 2 of the '056 application)

UF at ¶ 13; Wilcox Dec., Ex. G.

Illustration 8 shows a cross-section of the structure shown in Illustration 7:



Illustration 8

As with Illustration 6, in Illustration 8 the "generally planer first ply" of claim 1 is labeled "1." The "second ply" including "a multiplicity of cross plies" is labeled "2" and the second "first ply" appears at "3." That the multiplicity of cross plies of the second ply are thick and end in half circles is of no matter as claim 2 contains no limitation on the thickness or general shape of the cross plies. As to the shape of the second "first ply," claim 1 requires that the first ply be "generally planer." A ply having grooves in the bottom is still "generally planer." Moreover, as previously stated, the existence of the additional ply - the so-called second first ply - in claim 2 is at best assumed. As such, no language appears in claim 2 that limits the shape of this ply.

Although Battens Plus has here cited its expert's opinion to show that a person of ordinary skill would understand the teaching of the '056 application discussed here, such an opinion is unnecessary for this Court to decide anticipation. The structures disclosed in the '056

application do not require an expert's interpretation. Rather, the technology appearing in both the '193 patent and the prior art is easily understood by a lay person. Once the meaning of the claims is determined, this Court can determine for itself whether the structures disclosed in the '056 application anticipate claim 2. *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 1573 (Fed. Cir. 1984) (court may determine validity without expert testimony where the patent and prior art references are easily understandable). Hence, this Court may ignore any attempt by Diversi-Plast to manufacture an issue of fact as to anticipation with competing expert opinions. Once the claims are construed, a determination on summary judgment is appropriate.

As has been shown here, if the claim interpretations proposed by Battens Plus here are adopted by the Court, there is no genuine issue of material fact as to anticipation by the '056 application and this Court may grant this motion for summary judgment.

B. In Addition to Being Anticipated, Claim 2 is Rendered Obvious by Various Combinations of Prior Art

If this Court were to find that the '056 application is missing a limitation of claim 2, precluding anticipation, the '056 application renders the claim obvious in view of several roofing products that pre-date the filing of the '193 patent.

1. Legal Standard for Obviousness

A patent is obvious and invalid if the differences between the subject matter of the patent and the prior art are such that "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). "[O]bviousness does not require the prior art to reach expressly each limitation exactly. Rather, obviousness may render a claimed invention invalid where the record contains a suggestion or motivation to modify the prior art teaching to obtain the claimed invention." *Beckson Marine v. NFM Inc.*, 292 F.3d 718, 727 (Fed. Cir. 2002) citing *B.F. Goodrich Co. v. Aircraft Banking Sys. Corp.*, 72 F.3d 1577, 1582 (Fed. Cir. 1996). Showing a motivation to combine is key to obviousness. One challenging a patent must "show reasons that

the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). There are three possible sources for a motivation to combine references: "the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art." *Id.*

2. Invalidating Combinations

A person having ordinary skill in the relevant art would have known to combine the teachings of the '056 application with either the teaching of U.S. Patent No. 5,304,095 (the "'095 patent") or similar pre-existing Cor-A-Vent roof ventilator products to achieve the invention of claim 2. Wilcox Dec., Ex. I; Dregger Dec., Ex. D.

The '095 patent was published by the U.S. Patent and Trademark Office on April 19, 1994, prior to the December 17, 1998 filing date of the application to which the '193 patent claims priority. The '095 patent is thus prior art to which an ordinarily skilled artisan would have had access. UF at ¶ 17.

The '095 patent discloses a roof ridge cap ventilator system. This system consists of two long multi-ply structures having convolutions to allow air passage. These two structures are connected by a single ply. Wilcox Dec., Ex. I, at Fig. 4. The ventilator is placed over the ridge of the roof on the roofing felt or underlayment and then covered by further roofing materials such as tile. *Id.* at 1:41-43, Figs. 6 and 7. The purpose of the system is to provide ventilation for an attic through a hole in the ridge of the roof and then through the convolutions of the multi-ply structures. The plies of the multi-ply structures are identical to those disclosed in the '193 patent. Compare Figs 8, 9, and 10 of Wilcox Dec., Ex. I with Figs. 2, 4, and 6 of Wilcox Dec., Ex. C.

Prior to 1998, Cor-A-Vent, Inc. sold ridge vent products, including the V-300 and V-400 series ridge vents, having structures similar to those disclosed in the '095 patent. UF at ¶ 15;

Dregger Dec., Ex. D; Dregger Dec., Ex. E; Dregger Dec., Ex. A, at pp. 8-12. Unlike the vent disclosed in the '095 patent, the Cor-A-Vent products were intended to be installed on a roof ridge on top of tiles, then covered with additional tiles. Dregger Dec., Ex. E, at Fig. 7. As with the '095 patent, the plies of the multi-ply structures in the Cor-A-Vent products are identical to those appearing in the '193 patent. Compare Dregger Dec., Ex. D to Fig. 2 of Wilcox Dec., Ex. C.

The ridge vents taught by the '095 patent and the Cor-A-Vent products are effectively battens connected by a single ply and placed over the ridge of a roof. If this Court were to decide that the structures disclosed in the '056 application for some reason did not satisfy the limitations of claim 2, the substitution of the multi-ply structures disclosed in either the '095 patent or by the Cor-A-Vent products surely would meet these limitations.¹² These multi-ply structures show the cross-ply and parallel plies allegedly required by claim 2. To prove invalidity for obviousness, Battens Plus need only show that an ordinarily skilled artisan would have known to make such a substitution.

3. An Ordinarily Skilled Artisan Would Have Been Motivated To Combine This Art

An ordinarily skilled artisan would have been motivated to combine the '095 patent or the Cor-A-Vent art with the teaching of the '056 application to achieve claim 2 of the '193 patent for a variety of reasons. First, the teaching of these prior art references is very similar. All three references describe elements intended for use in tile roofs. Each of the references contain elements, the battens in the '056 application and the two ridge vents, intended to serve as spacers separating roof tiles from the overlayment of the roof. Second, each of the references attempt to solve a similar problem - that of promoting tile roof ventilation. Dregger Dec., Ex. A, at p. 10.

The general knowledge of the ordinarily skilled artisan would also suggest such a

¹² Battens Plus notes that the cross-ply in Figs. 8, 9 and 10 of the '095 patent are not perpendicular, however, there is no such requirement in claim 2.

combination. Such an artisan would understand that the greater the percentage of cross sectional openings in a batten, the better the air flow through that batten. The multi-ply structures disclosed by both the Cor-A-Vent products and the '095 patent would have a greater percentage of cross sectional openings than those taught by the '056 application. Thus, an ordinarily skilled artisan would be led to make the substitution. That the multi-ply structures have smaller holes, less easily infiltrated by insects than the '056 application's battens, and that the multi-ply structure was also commercially available would have also suggested such a combination. Finally, the dimensions of the multi-ply structures appearing on each half of the ridge vent disclosed in the '095 patent are similar to those of a batten. This would suggest to a ordinarily skilled person that the structures could be used individually as battens. *Id.* at 11-12.

Diversi-Plast will undoubtedly cite expert assertions as to the lack of motive to combine these prior art references arguing that such assertions create an issue of fact precluding summary judgment. To preclude summary judgment, however, Diversi-Plast must create a genuine issue of material fact - one upon which a jury could reasonably return a verdict of non-obviousness. Given the similarity of these references and the motivations to combine them stated here, there is no genuine issue of material fact. The '056 application in combination with either the '095 patent or the Cor-A-Vent products renders claim 2 of the '193 patent obvious and this Court should so rule on summary judgment.

C. The BattenUp Batten Does Not Infringe Claim 2 of the '193 Patent

There is no way to construe claim 2 in a way that both includes the accused product and excludes anticipation by the '056 application as described previously. Thus, if this Court determines that the '056 application does not anticipate claim 2, it must, as shown here, find that the accused BattenUp batten does not infringe claim 2.

1. Legal Standard for Infringement

"[A]n infringement analysis is a two-step process: 'First, the court determines the scope

and meaning of the patent claims asserted . . . [and second,] the properly construed claims are compared to the allegedly infringing device." *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 1366 (Fed. Cir. 2005) quoting *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998 (*en banc*)). Hence, as with anticipation, this Court must construe the claims prior to adjudicating the issue of infringement. Moreover, as with anticipation, because the technology at issue is relatively simple and the structures easily understood, once claim 2 is properly construed, the Court can easily determine whether the accused product infringes.

2. Noninfringement in the Alternative

For purposes of this non-infringement argument, Battens Plus will assume that the structure of its accused BattenUp batten is similar to the structure appearing in Fig. 5 of the '193 patent.¹³ Battens Plus here also focuses only on those portions of claims 1 and 2 of the '193 patent that describe the structure of the batten (i.e., Wilcox Dec., Ex. C, at 5:30-36).¹⁴ Fig. 5 of the '193 patent appears in Illustration 9:

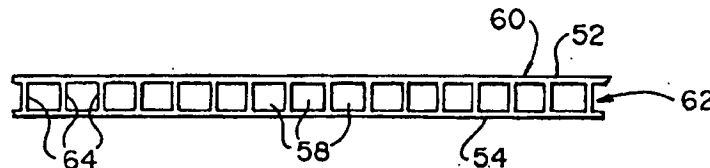


Illustration 9 (Fig 5 from the '193 patent)

Wilcox Dec., Ex. C. As previously stated, in Fig. 5 the first ply, 52, is not shown to be a separate entity divisible from the second ply, 62. The same is true of the accused product.

Diversi-Plast's technical expert, Mr. Steve Carpenter, suggested in his rebuttal report that claim 2 of the '193 patent requires separate divisible plies. When attempting to differentiate the Neumann Patent ('056 application) from claim 2, Mr. Carpenter opined:

The Neumann Patent only shows different configurations of a piece of block-like

¹³ Battens Plus does not admit this assumption nor should this assumption be taken as an admission.

¹⁴ Again, Battens Plus makes no admission that it sells a product that meets the limitations of these claims that are not discussed.

lath with holes milled or formed in it, and does not show discrete plies, such as the first, second, and cross plies of claim 2 and the figures and specification of the '193 patent.

Wilcox Dec., Ex. U, at 5 (emphasis supplied). To the extent Mr. Carpenter is correct that claim 2 requires discrete plies, neither the structure of Fig. 5 nor the accused product meets the limitations of claim 2.

As has been elegantly stated: "A patent may not, like a 'nose of wax,' be twisted one way to avoid anticipation and another to find infringement." *Amazon.com, Inc. v. Barnesandnoble.com*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (internal citations omitted). Diversi-Plast cannot have it both ways; it cannot avoid anticipation with discrete plies but claim infringement with integrated plies. If this Court adopts a construction in which the plies must be discrete, there is no genuine issue of material fact as to infringement and the Court may find non-infringement on summary judgment.

Neither the accused product nor Fig. 5 fall within the limitations of claim 2 for another reason. Because claim 2 depends from claim 1, it adds a limitation to claim 1. *Curtiss-Wright Flow Corp. v. Velan Inc.*, 2006 U.S. App. LEXIS 3521 at *15 (Fed. Cir., Feb. 15, 2006). Claim 2 is, thus, narrower than claim 1. If, therefore, the accused product and Fig. 5 fall within the limitations of claim 2, they must also fall within the limitations of claim 1. *AK Steel Corp. v. Sollac*, 334 F.3d 1234, 1241 (Fed. Cir. 2003) (independent claim must be at least as broad as the dependant claims depending from them). Should the accused product appear to fall with claim 2 but outside claim 1, that fact should indicate to this Court that there is a serious error in claim construction.

Claim 1 claims only two plies and requires that the two plies be "cooperating to define a multiplicity of passages extending generally transversely to a longitudinal axis of the batten." Wilcox Dec., Ex. C, at 5:31-34. Fig. 5 with the second planer ply, 54, removed appears in Illustration 10:



Illustration 10 (Portion of Fig. 5 of the '193 patent)

As shown in Illustration 10, the first and second plies of Fig. 5 do not cooperate to define a multiplicity of passages as is required by the language of claim 1. Rather, the two plies merely form grooves in the bottom of the battens. Hence Fig. 5 and the accused product do not fall within the limitations of claim 1 and, therefore, cannot be covered by claim 2. Based on this analysis, there is no proper construction of claim 2 that would include Fig. 5 and the accused product and there can be no infringement.

D. Claim 2 of the '193 Patent is Invalid Due to Prior Invention

Any invention described by claim 2 of the '193 patent was not invented by Richard J. Morris, the person listed on the '193 patent as its inventor. Rather, any invention of claim 2 was conceived and built by Lars J. Walberg in the summer of 1997, more than six months before Richard J. Morris conceived or worked on the idea. Claim 2 is, therefore, invalid for prior invention under 35 U.S.C. § 102(g).¹⁵

1. Legal Standard for Invalidity by Prior Invention

"[I]f a patentee's invention has been made by another, prior inventor who has not abandoned, suppressed, or concealed the invention, § 102(g) will invalidate that patent." *Dow Chemical Co. v. Astro-Valcour, Inc.*, 267 F.3d 1334, 1339 (Fed. Cir. 2001) quoting *Apetex USA, Inc. v. Merck & Co.*, 254 F.3d 1031, 1035 (Fed. Cir. 2001). The section 102(g) analysis

¹⁵ Diversi-Plast has submitted an application to the U.S. Patent and Trademark Office under 35 U.S.C. § 256 to name Mr. Walberg as a co-inventor of the '193 patent. Wilcox Dec., Ex. T. The propriety of altering the inventorship is discussed in Battens Plus' companion summary judgment motion. Regardless of this issue, the Patent Office has not yet acted on this application and, given its recent rejection of all the claims, may never reissue an amended patent. At this time, the Court must consider the '193 patent in its current form, which names Mr. Morris as the sole inventor.

proceeds in two steps. First, the proponent of invalidity establishes that the invention was conceived and reduced to practice by someone other than the listed inventor. *Sandt Tech., Ltd. c. Resco Metal and Plastics Corp.*, 264 F.3d 1344, 1350 (Fed. Cir. 2001) ("A prior art device can anticipate a claimed invention under § 102(g)(2) if it was conceived and reduced to practice prior to the filing date of the patent."). Second, on a showing of prior invention, the patentee may counter that the prior inventor "abandoned, suppressed or concealed the invention." *Dow Chemical Co.*, 267 F.3d at 1339. The latter may be shown in two ways: with evidence that the prior inventor actively concealed the invention or with evidence that the prior inventor unreasonably delayed in making the invention publicly known. *Eolas Tech. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1335 (Fed. Cir. 2005).

2. Lars J. Walberg Invented Claim 2

Diversi-Plast admits that the idea that led to the '193 patent originated with Lars Walberg in mid to late 1997. Wilcox Dec., Ex. V, at 37:21-38:21. Diversi-Plast also admits that Mr. Walberg built and tested the invention he conceived. *Id.* at 43:10-13. Richard Morris alleges that he first started working on the idea that led to the patent after a meeting in January 1998 where ideas originating with Mr. Walberg and conveyed through Diversi-Plast's marketing manager, Gary Urbanski, were discussed. Wilcox Dec., Ex. L, at 29:23-30:6, 30:16-19, 116:19-117:20 and Wilcox Dec., Ex. W.

Lars Walberg testified that some time in 1997 or 1998, he formulated the idea of using a corrugated plastic product as a batten. Wilcox Dec., Ex. J, at 30:5-6, 31:2-34:2. Based on this idea, Mr. Walberg requested a product from Diversi-Plast that might be used as a batten. *Id.* at 34:3-35:9. Diversi-Plast sent Mr. Walberg several of its soffit vent products for experimentation. *Id.* at 34:20-35:9. Mr. Walberg then built a simulated roof deck, placed the soffit vent/battens on roofing felt on this deck and placed tiles on top of the battens. *Id.* at 36:3-38:14.

Mr. Walberg's testimony constitutes evidence of both conception and reduction to

practice. Diversi-Plast's deposition admissions and own internal documents corroborate this testimony. An internal Diversi-Plast memorandum states:

A customer in Colorado has experimented with this idea utilizing our soffit vent. They put it under tile on a prototype roof in their yard. It has been on the roof since early summer 1997.

Wilcox Dec., Ex. W. Richard Morris testified that the document containing this statement was created by Gary Urbanski in 1998. Wilcox Dec., Ex. L, at 111:21-112:20. Based on Mr. Urbanski's testimony, the "customer in Colorado" referred to in this document was Mr. Walberg. Wilcox Dec., Ex. V, at 38:11-21.

Mr. Walberg's corroborated testimony shows that he conceived and reduced to practice an invention utilizing a soffit vent as a batten. Diversi-Plast admits that this occurred in the "early summer of 1997," prior to Mr. Morris beginning his work on the invention. Wilcox Dec., Ex. W. Mr. Walberg's testimony also shows that his invention met the limitations of claim 2 requiring an overlayment, a tile and a batten disposable between the tile and overlayment. Wilcox Dec., Ex. J, at 36:3-38:14.

The soffit vent Mr. Walberg used as a batten also meets the limitations of claim 2 relating to the structure of the batten. During his deposition, Mr. Morris drew his recollection of the structure of a circa 1998 Diversi-Plast soffit vent.¹⁶ Wilcox Dec., Ex. K; Wilcox Dec., Ex. L, at 162:2-167:13. Mr. Morris also confirmed that the planer and corrugated structures represented in his drawing (Wilcox Dec., Ex. L) are plies. *Id.* at 165:11-167:13. Referring to the same drawing, Mr. Walberg confirmed that the soffit vent product he used had "layers of corrugated plastic." Wilcox Dec., Ex. J, at 47:15-49:20. Based on this testimony and the representation in Wilcox Dec., Ex. J, the soffit vent that Mr. Walberg used as a batten in 1997 met all of the limitations of claim 2. Referring to labels 1, 2, and 3 appearing in Wilcox Dec., Ex. J, "3" is a

¹⁶ In addition to being the '193 patent inventor, Mr. Morris was a General Manager at Diversi-Plast in 1998 and, therefore, is familiar with the structure of Diversi-Plast's circa-1998 soffit vent products. Wilcox Dec., Ex. L, at 19:24-20:1.

planer first ply, "2" is a second ply having multiple cross plies and "1" is a second first ply.

Based on this evidence, there is no genuine issue of material fact that Mr. Walberg's invention met all the limitations of claim 2 and was conceived and reduced to practice before Mr. Morris began work on the invention of the '193 patent. The evidence also demonstrates that Mr. Walberg neither concealed his invention nor unreasonably delayed in making his invention publicly known. Rather, Diversi-Plast's own internal document shows that Mr. Walberg freely disclosed his invention to, at least, Diversi-Plast. Wilcox Dec., Ex. K. This Court should, thus, find claim 2 invalid under section 102(g).

VI. CONCLUSION

Based on the foregoing, claim 2, the only claim of the '193 patent asserted against Battens Plus, is both invalid and not infringed. Because there is no genuine issue of material fact on these issues, this Court should grant summary judgment in Battens Plus' favor.

DATED: March 31, 2006.

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